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Examiner: Yaritza Guadalupe
Group Art Unit: 2859

REMARKS/ARGUMENTS

Claims 1-68 were pending in the application. By the present amendment, claims 57 and 58 have been cancelled and new claims 69-72 have been added. Claims 69-72 relate to the subject matter of cancelled claims 57 and 58 but have been rewritten to give Applicant more complete protection for his invention. Support for the subject matter of claims 69-72 are found in paragraphs 62-64 and FIGS. 4, 6 and 7, all as filed. Paragraph 22 of the specification has been amended and new paragraph 22.1 had been added to provide specific support for new claims 69-72 and for amended claim 59. Claims 1, 57, and 58 stand rejected under 35 U.S.C. §102(b). Claims 2-21 and 59 stand objected to, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 59 has been rewritten in independent form although all of the limitations of cancelled claim 57 have not been incorporated into rewritten claim 59 for the sake of clarity. Claims 22-56 and 60-68 stand allowed. Applicant appreciates the Examiner's thorough job of examining this application and the early notification of allowable subject matter.

Reconsideration and reexamination of the application is respectfully requested in view of the forgoing amendments and the following remarks.

Rejection Under 35 U.S.C. §102(b)

Claims 1, 57, and 58 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 4,771,548 to Donnery. The rejection is respectfully traversed.

The claimed invention is not anticipated under §102 unless each and every element of the claimed invention is found in the prior art. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 90 (Fed. Cir. 1986).

Claim 1 describes a method comprising the steps of inclining a standing person's lower leg forwardly about one of the person's feet a preselected angle from the vertical, and measuring the lateral angular alignment of the foot while maintaining the person's lower leg in the forward inclined position at the preselected angle.

Donnery '548 discloses a biplane goniometer 10 comprising a rectangular platform 13 and an elongated arm 14 pivotally attached to a longitudinal edge of the platform at one end thereof. The arm 14 comprises a circular portion 17 concentric with the pivotal attachment 15

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and having a 360° protractor inscribed thereon. The protractor extends below the platform 13. The arm 14 also comprises a medial reference line 18 extending longitudinally along the arm 14 and passing through the pivot connection 15.

The goniometer 10 is used to measure the dorsiflexion of the foot relative to the lower leg. While the patient is in a reclining or seated position, the platform 13 is placed against the bottom of the foot and the arm 14 is aligned with the lateral side of the lower leg so that the reference line 18 is aligned with the center of the fibular head and the center of the lateral malleolus. The foot and platform 13 can be flexed upwardly and downwardly while maintaining the arm 14 in position relative to the fibular head and the lateral malleolus, and the angular displacement of the arm 14 relative to the platform 13, corresponding to the dorsiflexion of the foot, can be determined from the protractor. *Fig. 2; col. 3, ln. 15-46.*

Dorsiflexion is "flexion in a dorsal direction; especially, flexion of the foot in an upward direction." *Merriam-Webster's Medical Desk Dictionary, Rev. Ed.; © 2002; Merriam-Webster, Inc.* Thus, the numerous references in Donnery '548 to dorsiflexion are to the flexure of the foot in an upward and downward direction, as illustrated in Figures 1 and 2 of Donnery '548.

Claim 1 is not anticipated by Donnery '548. The Examiner's assertion that the method of claim 1 will be met during the regular operation of the goniometer disclosed by Donnery is misplaced.

Claim 1 requires that the person be standing on his or her foot while the person's lower leg is inclined forward and while the lateral angular alignment of the foot is measured. The goniometer described in Donnery '548 cannot be used while the person is standing on his or her foot because the protractor extends below the bottom of the platform 13, which would prevent the platform 13 from resting on the floor or another supporting surface. It is clear in Donnery '548, *col. 3, ln. 15-18*, that the goniometer must be used while the patient is reclining or seated. Thus, the goniometer of Donnery '548 cannot be used to complete the method steps of claim 1.

Furthermore, claim 1 requires that the person's lower leg first be inclined forwardly a preselected angle, and while the person's lower leg is inclined at the preselected angle, the lateral angular alignment of the foot is determined. Nowhere in Donnery '548 is there any discussion of determining the lateral angular alignment of the foot while the lower leg is inclined

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at a preselected angle. Donnery '548 describes inclining the lower leg relative to the foot, but the inclination is simply measured, not maintained at a preselected angle, and is not described as a step in the determination of the lateral angular alignment of the foot.

The Examiner asserts that the inclination of the leg and the lateral angular alignment measurement of the foot will be accomplished during the regular operation of the goniometer. The examiner is believed to in error. The "regular operation" of the goniometer in Donnery '548 is solely the measurement of dorsiflexion while the patient is in a reclining or seated position. The regular operation of the Donnery '548 goniometer does not include maintaining the inclination of the leg at a preselected angle from the vertical while the angular lateral alignment of the foot is measured.

Claim 1 is not anticipated by Donnery '548 under 35 U.S.C. §102(b) since "each and every element of the claimed invention" of claim 1 is not found in Donnery '548, *Hybritech, Inc., supra*. Claim 1 is in condition for immediate allowance.

New claims 69-72 are believed to patentably distinguish over the references of record in that they claim the combination of a base having a first portion adapted to be positioned beneath the heel of a person in a standing position and a second portion orthogonal with respect to the first portion and adapted to be placed adjacent to the Achilles tendon of the person whose heel is positioned on the base first portion; a heel alignment member adapted to be positioned on the heel of the person whose heel is positioned on the base first portion; and a protractor scale indicia on one of the base second portion and the heel alignment member and a reference line indicia on the other of the base second portion and the heel alignment member, wherein the reference line indicia is aligned with a zero position on the protractor scale indicia when the person's heel has a zero angular alignment and is adapted to indicate on the protractor scale indicia the degree of angular deviation of the person's foot from zero angular alignment. This concept is not disclosed in any of the references.

CONCLUSION

For the reasons discussed above it is believed that all of the claims are in condition for allowance. Early notification of allowability is requested.

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If there are any remaining issues which the Examiner believes may be resolved in an interview, the Examiner is invited to contact the undersigned.

Respectfully submitted,

ADRIANO ROSA

Dated: 22 September, 2004

By: 

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AMENDMENT AND FEE TRANSMITTAL LETTER

Docket No. 71480-0003

Applicant: ADRIANO ROSA

Serial No.
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July 18, 2003Examiner
Yaritza GuadalupeGroup Art Unit
2859

Invention:

CORRECTING FOOT ALIGNMENT

TO THE COMMISSIONER FOR PATENTS

Transmitted herewith is an amendment in the above-identified application.

The fee has been calculated as shown below.

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CLAIMS AS AMENDED

	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST # PREV. PAID FOR	NUMBER EXTRA CLAIMS PRESENT	RATE	ADDITIONAL FEE
TOTAL CLAIMS	70	68 =	2	2 x \$9	\$18.00
INDEP. CLAIMS	7	6 =	1	1 x \$42.00	\$42.00
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT					\$60.00

- ☐ No additional fee is required for amendment.
- ☒ Applicant claims small entity status.
- ☒ Please charge Deposit Account No. 50-2003 in the amount of \$60.00. A duplicate copy of this sheet is enclosed.
- ☐ A check in the amount of \$ to cover the filing fee is enclosed.
- ☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 50-2003. A duplicate copy of this sheet is enclosed.
- ☒ Any additional filing fees required under 37 C.F.R. 1.16.
- ☒ Any patent application processing fees under 37 C.F.R. 1.17.

Dated: September 23, 2004

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I certify that this document and fee is being transmitted by facsimile on September 23, 2004 to the Patent and Trademark Office to Examiner Yaritza Guadalupe, c/o Central Facsimile Number 703-872-9306.

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